

H? 22. (Amended) The sheet of claim 17 wherein the chlorinated polymer layer contains a UV absorber and a heat stabilizer.

### REMARKS

Claims 1 to 25 are pending in the application upon entry of the above amendments. Claims 1, 5, 9, 17 and 22 have been amended for clarification purposes. Support for the amendments to the claims can be found in the specification as filed. Favorable reconsideration in light of the above amendments and the remarks which follow is respectfully requested.

Additionally, the specification has been amended to correct a number of inadvertent typographical errors. No new matter has been added. Accordingly, entry of the amendments to the specification is believed to be warranted and is respectfully requested.

Furthermore, the Examiner's statement that claim 7 is not rejected in view of the art made of record is acknowledged with appreciation.

#### I. The 35 U.S.C. § 112 Second Paragraph Rejections:

Claims 1 to 17 and 22 have been rejected under 35 U.S.C. § 112, second paragraph, as indefinite as specified on page 2 of the Office Action dated February 6, 2002.

Claims 1, 5, 9, 17 and 22 have been amended. In light of the amendments made thereto, it is believed that the rejections of claims 1 to 17 and 22 under 35 U.S.C. § 112, second paragraph, have been rendered moot. Accordingly, withdrawal thereof is respectfully requested.

II. The 35 U.S.C. § 102(b) Rejections:

Claim 1 has been rejected under 35 U.S.C. §102(b) over Johnson et al. (U.S. Patent No. 5,518,786). These rejections are respectfully traversed because neither piece of cited art discloses, teaches or suggests a multilayer decorative sheet as is recited in pending claim 1.

The invention, in one embodiment as presently recited in claim 1, relates to a multilayer decorative sheet comprising:

- (a) a clear coat having a first and second surface,
- (b) a tie coat layer on the second surface of the clear coat layer,
- (c) a fade print layer on the tie coat layer, and
- (d) a pressure-sensitive adhesive layer on the fade print layer.

Johnson et al. relates to flexible decorative sheets for use in surfacing an automobile body which include a carrier; a clear coat layer which is formed from a fluorocarbon resin and an acrylic resin, the clear coat layer being coated on the surface of the first carrier sheet; a tie coat on the clear coat; and a color coat containing a chlorinated polymer with dispersed pigments cast on the tie coat and dried. A pressure-sensitive adhesive layer is formed on a second polyester carrier sheet and then laminated to the exposed face of the color coat to form a pressure-sensitive, adhesive-backed composite paint coat between the outer carrier sheets which form protective removable backing sheets for the resulting laminate.

As noted above, the pending claim 1 is directed to a multilayer decorative sheet comprising: (a) a clear coat having a first and second surface, (b) a tie coat layer on the second surface of the clear coat layer, (c) a fade print layer on the tie coat layer, and (d) a pressure-sensitive adhesive layer on the fade print layer.

In view of the above, Johnson et al. fails to disclose, teach or suggest the claimed multilayer decorative sheet as recited in pending claim 1. This is because Johnson et al. fails to disclose, teach or suggest a multilayer decorative sheet which contains, in part, a fade print layer, the fade print layer being disposed on a tie coat layer. As is discussed at page 1, line 24 to page 2, line 3 of the specification as filed:

[i]t is difficult to provide a conventional process for painting an automobile which provides a gradual and consistent fade of one color into another. Careful process controls are required to provide a fade of one color into another. Even if it was able to provide such paint, it would require a multistep process and be labor intensive.

The presently claimed invention overcomes the above problem by providing a fade print layer which, as is discussed at page 14, lines 1 to 21, has a varied degree of opacity over the width of the decorative sheet.

As can be seen from the disclosure contained at column 10, line 45 to column 13, line 18, Johnson et al. fails to disclose, teach or suggest a decorative sheet having a fade print layer as is recited in pending claim 1.

Furthermore, Applicants disagree with the Examiner's position that a fade print layer is inherent in the cited art. As is well settled, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 28 USPQ.2d 1955, 1957 (Fed. Cir. 1993). To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." In re Roberstson, 49 USPQ2d 1949 (Fed. Cir. 1999) Furthermore, it is well settled that "[i]nherency . . . may

not be established by probabilities or possibilities. There mere fact that a certain thing may result from a given set of circumstances is not sufficient." Id. quoting In re Oelrich, 212 USPQ 323, 326 (CCPA 1981).

In light of the disclosure contained therein, one of ordinary skill in the art would recognize that the color layer of Johnson et al. is a uniform color coat. This is because the Johnson et al. fails to teach or suggest a method for forming a fade print layer or the desirability or benefits thereof. As such, one of ordinary skill in the art would recognize that a fade print layer is not inherent in the disclosure contained in Johnson et al.

Since Johnson et al. fails to disclose, teach or suggest each and every feature of the claimed invention, claim 1 is patentable thereover. Accordingly, withdrawal of the novelty rejection of claim 1 is respectfully requested.

III. The 35 U.S.C. § 103(a) Rejections:

Claims 2 to 6, 10 and 16 have been rejected under 35 U.S.C. § 103(a) over Johnson et al. The teachings of Johnson et al. are discussed in detail above.

With regard to the obviousness rejection of claims 2 to 6, 10 and 16, Johnson et al. fails to render claims 2 to 6, 10 and 16 obvious in light of the fact that Johnson et al. fails to teach or suggest a multilayer decorative sheet having a structure as recited in pending claim 1. That is, Johnson et al. fails to teach or suggest a multilayer decorative sheet having, in part, (d) a fade print layer on the tie coat layer.

As noted above, a decorative sheet according to the present invention permits gradual and consistent fade of one color into another due, in part, to the claimed fade print layer.

Since Johnson et al. fails to teach or suggest the multilayer decorative sheet structure recited in pending claim 1, claims 2 to 6, 10 and 16 (all of which depend directly from claim 1) are patentable over the art made of record. Accordingly, withdrawal of the above-mentioned obviousness rejection is respectfully requested.

Claims 8 and 9 have been rejected under 35 U.S.C. § 103(a) over Johnson et al. in view of Ellison et al. (U.S. Patent No. 54,931,324). The teachings of Johnson et al. are discussed in detail above.

Ellison et al. relates to flexible decorative sheets for use in surfacing automobiles. The decorative sheets disclosed in Ellison et al. contain a substantially clear outer film 11 which is selected so that it is transparent, thermoformable and weatherable. Among the compounds/polymers disclosed as useful for layer 11 are urethane polymers and fluoropolymers.

The Examiner contends that it would have been obvious to one of ordinary skill in the art to combine the teachings of Johnson et al. and Ellison et al. to yield the structures recited in pending claims 8 and 9. Applicants disagree.

In light of the disclosure contained therein, Ellison et al. fails to cure the deficiencies of Johnson et al. That is, Ellison et al. also fails to teach or suggest a multilayer decorative sheet having, in part, (c) a fade print layer on the tie coat layer, as recited in pending claim 1.

As such, the combination of Johnson et al. and Ellison et al. cannot render obvious claims 8 and 9, since these claims depend directly from claim 1.

Claims 11 to 15 and 17 to 25 have been rejected under 35 U.S.C. § 103(a) over Johnson et al. in view of Carroll, Jr. (U.S. Patent No. 5,192,609). Claims 11 to 15 depend, either directly or indirectly from claim 1. Claim 1 relates to a multilayer decorative sheet comprising:

- (a) a clear coat having a first and second surface,
- (b) a tie coat layer on the second surface of the clear coat layer,
- (c) a fade print layer on the tie coat layer, and
- (d) a pressure-sensitive adhesive layer on the fade print layer.

The invention, in another embodiment as presently recited in claim 17, relates to a decorative automobile sheet comprising:

- (a) a clear coat comprising a blend of a fluorocarbon polymer and an acrylic or methacrylic resin having a first and second surface,
- (b) an acrylic tie layer on the second surface of the clear coat layer,
- (c) a fade print layer on the tie coat layer,
- (d) an optically clear chlorinated polymer layer on the print layer, and
- (e) a pressure-sensitive adhesive adhered to the chlorinated polymer layer.

The teachings of Johnson et al. are discussed above in detail.

Carroll, Jr. relates to thermoformable basecoat/clearcoat sheet material which include a carrier film having a dark basecoat layer and, over the basecoat layer, a transparent layer which contains light reflective metallic flakes and, over the flake layer, a clear topcoat layer. The Examiner contends that it would have been obvious to one of ordinary skill in the art to incorporate the PVC carrier film (which the Examiner equates to the claimed backing layer and/or polymer layer) into the structure disclosed in Johnson et al. Applicants disagree.

In light of the disclosure contained therein Carroll, Jr. fails to disclose, teach or suggest the claimed fade print layer, as recited in pending claims 1 and 17. Since Carroll, Jr. fails to teach or suggest the claimed fade print layer, Carroll, Jr. fails to cure the deficiencies of Johnson et al.

As such, the combination of Johnson et al. and Carroll, Jr. cannot render obvious claims 11 to 15 and 17 to 25. Thus, withdrawal of the above-mentioned obvious rejection is believed to be warranted and action to this end is respectfully requested.

IV. Conclusion:

Thus, withdrawal of the above-mentioned rejections and allowance of claims 1 to 25 is respectfully requested.

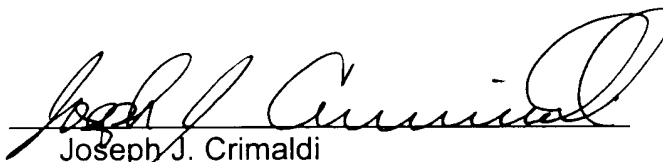
Should the Examiner believe that a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

In the event any fees are due in connection with the filing of this document, the Commissioner is authorized to charge those fees to our Deposit Account No. 18-0988 under Attorney Docket No. **AVERP2580USA**.

Respectfully submitted,

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## **APPENDIX**

The following contains a detailed listing of the changes made to the specification and the claims. Please note, underlining denotes additions and [~~bracketed-strikeout~~] denotes deletions.

### In The Specification:

The specification has been amended as shown below.

Page 17, line 25 to page 18, line 4:

In another embodiment, the decorative sheet is represented by Fig. 3. The decorative sheet of Fig. 3 has carrier 10, top coat 12, tie coat 14 and fade print layer 16 as described above. On fade print layer 16 is a printed tie layer 26 which improves adhesion of the fade print layer to back coat 22. The tie coat has a thickness of about 0.05 to about 0.5, or about 0.1 to about 3, or about 0.2 mil. Back coat 22 is described above. Tie layer 26 [~~22~~] is an acrylic based tie layer that improves the adhesion of back coat 22 to the faded print layer 16. The tie layers include those described above. Back coat 22 is also attached to carrier 20 through pressure-sensitive adhesive 24. Those components have been described above.

Page 24, lines 7 to 9:

Another decorative sheet is prepared as described in example 1 except there is no [~~not~~] back coat and the clear coat is a 2 mil PVC film is used instead the blended clear coat, and a screen printed urethane cover coat is applied to the PVC clear coat.

### In The Claims:

Claims 1, 5, 9, 17 and 22 have been amended as shown below.

1. (Amended) A multilayer decorative sheet comprising:
  - (a) a clear coat having a first and second surface,
  - (b) a tie coat layer on the second surface of the clear coat layer,
  - (c) a fade print layer on the tie coat layer, and
  - (d) a pressure-sensitive adhesive layer on the fade print layer.

5. (Amended) The sheet of claim 4 [~~4~~] wherein the halogenated polymer is polyvinylidene fluoride or polyvinyl chloride.



9. (Amended) The sheet of claim 8 further comprising a polyurethane cover coat over ~~over~~ the clear coat.

17. (Amended) A decorative automobile sheet comprising:
- (a) a clear coat comprising a blend of a fluorocarbon polymer and an acrylic or methacrylic resin having a first and second surface,
  - (b) an acrylic tie layer on the second surface of the clear coat layer,
  - (c) a fade print layer on the tie coat layer,
  - (d) an optically clear chlorinated polymer layer on the print layer, and
  - (e) a pressure-sensitive adhesive adhered to the chlorinated polymer layer~~and~~.

22. (Amended) The sheet of claim 17 wherein the chlorinated polymer layer contains a UV absorber and a heat stabilizer.